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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,303	11/14/2003	Brian S. McCain	TUC920030126US1 (16991)	2111
46263 7590 06/05/2007 SCULLY, SCOTT, MURPHY, & PRESSER 400 GARDEN CITY PL GARDEN CITY, NY 11530			EXAMINER DAO, THUY CHAN	
			ART UNIT 2192	PAPER NUMBER
			MAIL DATE 06/05/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/714,303

Applicant(s)

MCCAIN, BRIAN S.

Examiner

Thuy Dao

Art Unit

2192

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on April 3, 2007 has been entered.

2. Claims 1-20 have been examined.

### **Response to Amendments**

3. Per Applicants' request, claims 1, 9, and 15 have been amended.

### **Response to Arguments**

4. The Applicant is thanked for a thorough reply. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### **Claim Objection**

5. Claims 1, 9, and 15 are objected to because of minor informalities. For consistency with other dependent claims, "client" and "host" should be changed to - -client host- - and - -server host- -, respectively.

### **Restrictions/Election**

6. Independent claim 15 has been significantly amended, which now explicitly direct to a distinct invention, thus prompt this Restriction requirement. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- (I). Claims 1-14 are drawn to a method and a program storage device for use by a client host in obtaining software of different versions of a network application from different server hosts, classified in class 717, subclass 172, Distribution of software upgrading/updating (emphasis added).

- (II). Claims 15-20 are drawn to a method for use by a server host in obtaining software comprising "...downloading first software from the first client host for use during the session to implement a server side ..." (lines 4-5, emphasis added) and "...enabling the client to ... download the different version of the same first network application from the different server..." (lines 9-11, emphasis added), which directs to a distinct and independent invention, classified in class 717, subclass 176, Software installation in network (emphasis added).

7. Group (I) is only drawn to distribution of software to a client host, said software are different versions of a network application from different server hosts, which does not require distinct and independent limitations such as a server host "downloading first software from the first client host ... to implement a server side" for said server host and further "enabling the client to ... download the different version ... from the different server [host]" (emphasis added).

8. Group (II) now amended to include at least distinct and independent limitations "for use by a server host in obtaining software" from a client host, and further "enabling the client to ... download the different version ... from the different server [host]" (emphasis added).

9. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification (see MPEP 808.02), restriction for examination purposes as indicated is proper.

10. Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the

record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

11. Since the Applicants have received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, **claims 15-20** are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### **Claim Rejections – 35 USC §112, 1st paragraph**

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

#### **Claims 1 and 9:**

Claim 1 is the representative claim. Newly added limitations in lines 10-11 recites, "... *allowing the client to download the different version of the same first network application from the different server...*" (emphasis added), which contains subject matter which was not described in the specification.

The specification (e.g., [0013] and [0019]) discloses a network application includes at least client side and server software, and the client downloads and executes only the client side software, not the whole network application (emphasis added).

Based on claim 1, lines 4-5, the phrase is considered to read as - -... allowing the client to download second software of the different version of the same first network application from the different server ...- -.

**Claims 2-8 and 10-14:**

Claims 2-8 and 10-14 are also rejected based on virtue of their dependency on rejected claims 1 and 9, respectively.

**Claim Rejections – 35 USC §103**

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-14 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,212,548 to DeSimone et al. (art of record, hereinafter "DeSimone") in view of Admitted Prior Art (art of record, hereinafter "APA").

**Claim 1:**

DeSimone discloses a program storage device and *a method for use by a client host in obtaining software, comprising:*

*establishing a session with a first server host (e.g., FIG. 7, session 1, window 710, col.13-15); and*

*downloading first software from the first server host for use during the session to implement a client side of a first version of a first network application (e.g., col.1: 26-47),*

*the client side initially not having a functionality for implementing the first network application (e.g., col.1: 48-59);*

*wherein the first software is compatible with software executed at the first server host to implement a server side of the first version of the first network application (e.g., FIG. 1, col.3: 60 – col.4: 18):*

*enabling the client to communicate with a different server that is using a version of the first network application and allowing the client to download second software of the version of the same first network application from the different server (e.g., col.4: 3-37),*

*wherein the client is allowed to communicate simultaneously with one or more different servers even if the different servers are running the same first network application (e.g., FIG. 7, session 2, window 720, col.13-15; col.4: 38 – col.5: 21).*

DeSimone discloses many versions of a chat software (i.e., network application) with varying functionality and communications protocols (col.1: 48-59), but does not explicitly disclose *different versions of the same first network application* (i.e., different versions of a specific chat software).

However, APA further discloses *different versions of the same first network application* (e.g., [0002]). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine APA's teaching into DeSimone's teaching. One would have been motivated to do so to provide new versions, which have new features or accommodate hardware changes at the hosts as suggested by APA (e.g., page 1, 13-15).

#### **Claim 2:**

The rejection of claim 1 is incorporated. DeSimone also discloses *downloading the first software from the first server host dynamically, as needed, by the client host* (e.g., col.1: 48-59).

#### **Claim 3:**

The rejection of claim 1 is incorporated. DeSimone also discloses *the client host initiates the downloading when it determines that it needs the first software to interact with the first server host* (e.g., col.2: 29-56).

**Claim 4:**

The rejection of claim 1 is incorporated. DeSimone also discloses *downloading the first software as at least one object using at least one specialized class loader (e.g., col.4: 19-29; col.5: 40-54).*

**Claim 5:**

The rejection of claim 1 is incorporated. As set forth above, DeSimone and APA also discloses:

*establishing a session with a second server host; and downloading second software from the second server host for use during the session therewith to implement a client side of a second version of the first network application that differs from the first version (e.g., FIG. 7, session 2, window 720);*

*wherein the second software is compatible with software executed at the second server host to implement a server side of the second version of the first network application (e.g., col.13-15).*

**Claim 6:**

The rejection of claim 5 is incorporated. DeSimone also discloses *the sessions with the first and second server hosts overlap, at least in part (e.g., FIG. 7, sessions 1 and 2 overlaps with each other).*

**Claim 7:**

The rejection of claim 1 is incorporated. DeSimone also discloses:

*establishing a session with a second server host; downloading second software from the second server host for use during the session therewith to implement a client side of a second network application that differs from the first network application (e.g., col.1: 26-59);*



*wherein the second software is compatible with software executed at the second server host to implement a server side of the second network application (e.g., col.4: 4-37).*

**Claim 8:**

The rejection of claim 1 is incorporated. DeSimone also discloses:

*establishing a further session with the first server host; downloading second software from the first server host for use during the further session to implement a client side of a second network application that differs from the first network application (e.g., col.2: 12-24);*

*wherein the second software is compatible with software executed at the first server host to implement a server side of the second network application; and the session and further session with the first server host overlap, at least in part (e.g., col.2: 29-56).*

**Claims 9-14:**

Claims 9-14 are program storage device versions, which recite the same limitations as those of claims 1-8, wherein all claimed limitations have been addressed and/or set forth above. Therefore, as the references teach all of the limitations of the above claims, they also teach all of the limitations of claims 9-14.

**Conclusion**

16. Any inquiry concerning this communication should be directed to examiner Thuy Dao (Twee), whose telephone is (571) 272 8570. The examiner can normally be reached on the first Monday of the bi-week, and every Tuesday, Thursday, and Friday from 6:00AM to 6:00PM.

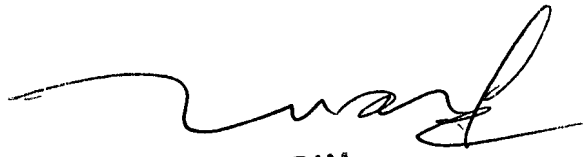
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam, can be reached at (571) 272 3695.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is (571) 272 2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

T. Dao



TUAN DAM  
SUPERVISORY PATENT EXAMINER